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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,603	06/11/2001	Peter A. Ward	UM-06340	4222

23535 7590 07/28/2004  
MEDLEN & CARROLL, LLP  
101 HOWARD STREET  
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SAN FRANCISCO, CA 94105

EXAMINER

VANDERVEGT, FRANCOIS P

ART UNIT PAPER NUMBER

1644

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/878,603

Applicant(s)

WARD ET AL.

Examiner

F. Pierre VanderVegt

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1644

### DETAILED ACTION

This application is a continuation of U.S. Application Serial Number 09/387,671.

Claims 3-12 and 15-19 have been canceled.

Claims 1, 2, 13 and 14 are currently pending.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1, 2, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is ambiguous and unclear in the recitation of “defined by an amino acid sequence” and “approximately five amino acids in length.” The terms are not defined in the specification in such a manner that the artisan would be able to determine the metes and bounds of the claims.

For example, a protein can be “defined” in terms of particular epitopes borne on the protein or in terms of antibodies or peptides that bind to the protein. Accordingly, is a peptide “defined” by SEQ ID NO: 14 or 15 a full-length protein that bears SEQ ID NO: 14 or 15 as part of its primary amino acid sequence?

Similarly, the metes and bounds of “approximately five amino acids” are not adequately defined in the specification. What is encompassed by the term “approximately” in the instant claims? Could the “portion” be 3 amino acids or even 1 amino acid residue? Given that SEQ ID NO: 14 and 15 represent fragments of the C5 protein, interpretation of the claim as reading upon a single amino acid residue is not unreasonable, as 1 amino acid is “approximately 5” when compared to full-length C5.

Accordingly, Applicant should present claim 1 in a manner that better conveys the metes and bounds of Applicant’s invention. For example, claim 1 could be amended (in a manner consistent with the specification to read:

--A composition comprising an isolated and purified peptide consisting of an amino acid sequence selected from the group consisting of SEQ ID NO: 14, SEQ ID NO: 15 and a portion thereof, wherein said portion is five amino acids in length.--

Applicant is reminded of the need to specifically point out the support for any amendments made to the disclosure. See MPEP 714.02 and 2163.06.

Art Unit: 1644

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Morgan et al (J. Immunol. [1992] 148(12):3937-3942; U on form PTO-892 of record).

Morgan teaches a composition comprising C5a anaphylatoxin (see entire document). C5a is a peptide sequence of which instant SEQ ID NOs: 14 and 15 are fragments. Accordingly, the primary amino acid sequence of SEQ ID NOs: 14 and 15 are defining elements of C5a. The prior art teaching anticipates the claimed invention.

*Conclusion*

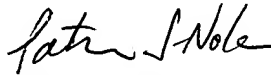
3. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Pierre VanderVegt whose telephone number is (571) 272-0852. The examiner can normally be reached on M-Th 6:30-4:00; Alternate Fridays 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

F. Pierre VanderVegt, Ph.D.   
Patent Examiner  
July 26, 2004

  
PATRICK J. NOLAN, PH.D.  
PRIMARY EXAMINER

7/26/04